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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,194	01/28/1999	JOHN S YATES JR.	114596-05-4013	9716

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EXAMINER

TANG, KENNETH

ART UNIT PAPER NUMBER

2195

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/239,194

Applicant(s)

YATES ET AL.

Examiner

Kenneth Tang

Art Unit

2195

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6/26/06 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 26 June 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 1-83.  
Claim(s) withdrawn from consideration: none.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 7/25/06  
13. ☐ Other: \_\_\_\_\_

*Handwritten Signature*  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2195

Continuation of 11. does NOT place the application in condition for allowance because: The request for Pre-Appeal Review was improper and non-compliant because a 23 page request for consideration is not allowed at the same time. The IDS submitted on 6/26/06 is not considered by the Examiner because the Applicant failed to make the statement in 1.97(e). The Applicant seems to think it is relevant that the reference of Robinson is similar to the reference previously considered. The outcome of the Appeal Conference in September 2005 involving Examiner Tang and Supervisor An led to reopening prosecution so that new grounds of rejections (involving additional reference mappings and new 112, 2nd paragraph rejections) could be made. Applicant's statement and highlight that the Appeal Conference reversed positions is simply incorrect. It is irrelevant that the reference of Robinson is similar to the reference previously considered. The Examiner made 112, 2nd paragraph rejections based on indefiniteness as well as lack of antecedent basis. Applicant responds to the rejection of antecedent basis but fail to address the Examiner's rejection of indefiniteness. As stated in the final office action, it is unclear whether there are one or two operating systems involved in claims 1 and 56. This uncertainty causes the scope of the invention to be undetermined, and therefore, the claims are indefinite. Applicant merely defines definiteness in the Remarks but fails to show how that definition is satisfied in the claims. Regarding the lack of antecedent basis rejections, Applicant responds by insinuating relationships between terms in the claim language that don't exist. For example, Applicant argues that "the operating system" in claim 1 has antecedent basis for "a pre-existing operating system". There is no relationship made that connects the two terms together and it is not clear in the claim language whether there are one or two operating systems. Applicant does not even make this clear in the Remarks and has completely avoided responding to this in the current Response as well as the prior Response. Similarly, it is unclear whether there are one or two thread schedulers in claim 5. Furthermore, it is unclear whether there are one or two operating systems in claim 33. The scope cannot be ascertained because of this unclarity, therefore, the 35 USC 112, 2nd paragraph rejections are proper. As to the argument of lack of antecedent basis for claim 46, the Applicant incorrectly states that antecedent basis support for "the extended context" (lines 2-3) is found afterwards (and not prior) in lines 3-4. An extended context is not inherent in a context. Therefore, "the extended context" (first time in line 3) should be replaced with "an extended context". In claim 43, Applicant argues that the context has inherent antecedent basis in "the interrupted process", however, the claim language does not make it clear that the particular context belongs to the interrupted process. If the claim indicated an interrupted process and its context, for example, then the Examiner would agree that there is inherent antecedent basis. However, this is not the case. In claim 79, Applicant argues that "the service" is inherent in "a service routine". Applicant disagrees on the inherency because the claim language doesn't make it clear that the particular service belongs to the service routine. As merely one example, passing a linkage return address could also be a "service." The scope of the claim is unclear and therefore indefinite. Applicant argues that none of the cited portions of Robinson correspond to a resumption exception. In response, the Applicant's cited portions teach both exceptions and resumptions. It is inherent that an exception (interrupt) is involved when performing a resumption. This exception would be the resumption exception and it is complementary to one of the specified entries by the resumption taking place at the entry point. A linkage return address from the cited portions of the reference, relates to the call instruction for execution and is deliberately chosen to perform its related call instruction. It is inherent that an exception/interrupt are involved when performing the return instructions or jump instructions. Applicant argues in claim 5 that the Examiner leaves out a portion of the recited claim. In response, the portion that was not included was the portion that was not taught by the primary reference but rather by the secondary reference. A 35 USC 103 rejection was made, NOT a 35 USC 102 rejection. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that there is no reasonable expectation of success nor motivation in Chernoff '028. In response, the Chernoff '028 was not even used in any of the rejections. The Examiner has shown that a reasonable expectation of success exists to combine Robinson with Bitar because they both relate to context switching, and therefore, it would be logical that they could be combined. The references do not teach away from each other. Applicant has not provided any evidence that show otherwise. Applicant argues that the entry handler and exit handler are not specifically identified. In response, the cited portions of the Office action showed that the exception handler handles exceptions to both entry and exit points. The exception handler performs the same function as both the entry handler and the exit handler. Applicant highlights that cited portions are used 16 columns away from each other and attempts to show that the references are read unfairly. In response, the cited portions both relate to translation. It is irrelevant how far one cited portion is located to another because they are related. Applicant specifically points out the differences between the two cited portions but avoids mentioning the similarities. Applicant also argues that the cited portion of Robinson never mentions context data structure 180. In response, context data structure 180 is part of the cited portion as item 180 in the Drawings/Figures. Furthermore, a few lines prior to making the argument, Applicant even admits on the record that Robinson discloses a "current state saved in context data structure". Applicant's arguments have been fully considered and were not found to be persuasive.